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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/227,770	01/08/1999	SURESH NARAYANA CHARI	YO999-002	7725

7590

09/25/2003

IBM CORPORATION  
INTELLECTUAL PROPERTY LAW DEPT  
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EXAMINER

JACKSON, JENISE E

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 09/25/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/227,770

Applicant(s)

CHARI ET AL.

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 5-26, 30-36, 38-40, 42-44 and 46-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-26, 30-36, 38-40, 42-44, and 46-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 5-26, 30-36, 38-40, 42-44, 46-59, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims above recite the limitation of a coprocessor and agent. The specification on page 7, states that given that a certain functionality is intended and expected of the application executing on the secure coprocessor, and external agent can neither subvert nor disrupt the execution of such an application. There is no mention in the specification of an agent embedded at the proxy, there is only support of a coprocessor that is embedded at the proxy. According to claim 1, the coprocessor is used as an agent, but according to the specification it seems as if there is a coprocessor and an agent, but the specification does not disclose the limitations that included an agent performing the functions related to it. Therefore, the claims above are lacking enablement, for not describing in the specification the function of the agent as it relates to the claims. The Examiner asserts is the coprocessor the same as the agent? The Examiner is unsure as it relates to the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1, 5-26, 30-36, 38-40, 42-44, 46-59, are rejected under 35 U.S.C. 112, second paragraph, as being unclear for “embedding a secure coprocessor for use as an agent, and “assures that the proxy cannot tamper with the functioning of the agent”, because page 7 of specification, is a negative impact on the system, this “agent”, which is a hostile element. However, the claim calls for coprocessor for use as an agent. If the agent is a hostile element, why is the coprocessor acting as an agent?

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 26, 35, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cashman et al.

Cashman discloses embedding a secure coprocessor(100) for use as an agent of the client(108), and server(107)(see fig. 1, sheet 1, see col. 7, lines 48-65), employing a proxy(i.e. network device)(104) between the client and the server to provide connection links between the client and server(see fig. 1, sheet 1), the coprocessor(100) acting as converter between at least one protocol the client(108) supports and at least one other protocol supported by the server(107), the Examiner asserts that Cashman discloses this because Cashman discloses that the coprocessor(100) can implement protocols on data in both the sending and receiving

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directions(see col. 8, lines 29-32), and employing respective security protocols of the at least one protocol and the at least one other protocol; the Examiner asserts that security protocol is broadly interpreted to be any protocol that is security related. Therefore, Cashman discloses employing respective security protocols of the at least one protocol and the at least one other protocol, because Cashman discloses that the coprocessor(100) performs protocols such as encryption and decryption(see col. 8, lines 19-20, col. 13, lines 27-29). Further, Cashman discloses splicing a plurality of secure communication protocols of different protocol suites into the agent, because Cashman discloses that the coprocessor can be programmed for multiple protocols(see col. 3, lines 44-48, col. 4, lines 39-50), and guarantees that an application(inherent), embedded in the coprocessor performs to a degree of security proscribed by the client and/or server(see col. 8, lines 6-26).

### ***Response To Amendment***

7. In response to Applicant's remarks, paper #5, dated June 26, 2003, the Applicant disagrees with the rejection of claims 4, 7-13, as being rejected under 112 first. The Applicant further states that claim 1, states "embedding a secure coprocessor for use as an agent of the client and/or server". The Applicant states that an embedded secure coprocessor is the antecedent basis or the entity, which functions as the agent. Furthermore, the Applicant states that the "agent" found on page 7, line 5, refers to an external hostile element whose interests are contrary to the client. The Examiner asserts that the claims are not enabled and are unclear for the limitations of "embedding a secure coprocessor for use as an agent, and "assures that the proxy cannot tamper with the functioning of the agent", because the cited portion the Applicant is referring to, is a negative impact on the system, this agent, which is a hostile element.

However, the claim calls for coprocessor for use as an agent. If the agent is a hostile element, why is the coprocessor acting as an agent? As per Applicants amendment all claims are rejected under 112 1<sup>st</sup> and 2<sup>nd</sup> as not being enabled and unclear.

8. The Applicant states that Cashman describes a method which uses a coprocessor to implement elements of the protocol translation process between client and server. Further, the Applicant states the coprocessor in their invention to enforce the trust model between the client and server. Further, the Applicant states that there is no end-to-end security. The Examiner disagrees(see pg. 2, previous rejection).

9. The Applicant states that the Examiner made some correct assertions and incorrect. However, fail to provide proof as to how the assertions are incorrect.

10. Lastly, the Applicant states the Cashman et al. does not disclose a tamper proof coprocessor and thus cannot maintain the trust model. The Examiner asserts that this is not disclosed in the claims. Therefore, this argument is moot.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
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September 21, 2003

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100